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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/325,040	06/07/1999	JON A. BREWSTER	10991693-1	2318

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/325,040

Applicant(s)
Brewster et al

Examiner
James W. Myhre

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 10, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above, claim(s) 23-32 and 49-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 33-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2,4,6-8 6) ☐ Other:

Art Unit: 3622

DETAILED ACTION

Response to Amendment

1. The Preliminary Amendment filed on July 10, 2000 has been entered. The currently pending claims in the application are Claims 1-76.

Election/Restriction

2. This application contains claims directed to the following patentably distinct species of the claimed invention: .

- I. Claims 1, 23-32, and 49-76, drawn to automatically printing documents, classified in class 340, subclass 309.15.
- II. Claims 1-22 and 33-48, drawn to subsidizing the printing of documents through the use of advertisements, classified in class 705, subclass 14.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic.

Art Unit: 3622

3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141, presently Claims 23-32. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Raymond A. Jensi on January 6, 2003 a provisional election was made without traverse to prosecute the invention of Group II, claims 1-22 and 33-48. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-32 and 49-76 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 3622

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 34-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 34-48 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. As in Claim 34, the steps of monitoring the usage of a printing device and subsidizing the purchase of a product based thereon could both be performed manually by a person filling in a log sheet sitting beside the printing device and a subsidizer handing a coupon or other subsidy to the person who filled out the log sheet. The dependent claims 35-48 also contain steps that could be performed manually, i.e. manually updating a card file containing the user profile and manually sending a letter with the profile data to the subsidizer/advertiser. Therefore, the claims are directed towards non-statutory subject matter.

Art Unit: 3622

To overcome this rejection, the Examiner recommends the Applicant amend Claim 34 to better reflect which of the steps are being performed within the technological arts by incorporating a computer into the monitoring and subsidizing steps, such as “electronically monitoring by a computer processor the usage of a printing device; and subsidizing the purchase of a product, based on the electronic monitoring step.” By placing independent Claim 34 within the technological arts, all of the dependent claims will automatically become statutory also.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 1-3, 12-15, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by

Griebenow et al (5,850,520).

Art Unit: 3622

Claim 1: Griebenow discloses a method for automatically printing a document, comprising:

- a. Storing a print schedule (col 4, lines 25-31 and col 8, lines 19-33);
- b. Automatically requesting, receiving, and printing the document without user intervention (col 4, lines 32-45 and col 8, lines 19-33).

Claim 2: Griebenow discloses a method for automatically printing a document as in Claim 1 above, and further discloses storing a user profile (col 6, lines 65-67).

Claim 3: Griebenow discloses a method for automatically printing a document as in Claim 2 above, and further discloses updating the user profile to reflect the printing of the document (col 7, lines 10-55).

Claim 12: Griebenow discloses a method for automatically printing a document as in Claim 2 above, and further discloses including advertising content in the document (col 5, lines 12-22).

Claims 13, 14, and 33: Griebenow discloses a method for automatically printing a document as in Claims 3 and 12 above, and further discloses personalizing the advertising content and the document content based on the user profile (col 5, lines 12-22 and col 6, lines 65-67).

Claim 15: Griebenow discloses a method for automatically printing a document as in Claim 13 above, and further discloses updating the user profile to reflect the printing of the document (col 7, lines 10-55).

Art Unit: 3622

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-11, 16-22, and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al (5,850,520) in view of Logan et al (5,721,827).

Claims 4 and 16: Griebenow discloses a method for automatically printing a document as in Claims 3 and 15 above, but does not explicitly disclose subsidizing a product for a user based on updating the user profile. However, Logan discloses a similar method for printing document which include advertisements like Griebenow and which also discloses subsidizing the user based on updating the user profile (col 26, lines 53-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the advertising revenue discussed in Griebenow (col 6, lines 2-12) to subsidize the cost to the user for printing the document. One would have been motivated to subsidize the user's cost in this way in order to entice the customers to use the system.

Claims 5-11, 17-22, and 39-42: Griebenow and Logan disclose a method for automatically printing and subsidizing a document as in Claims 4, 16, and 34 above. Griebenow and Logan both further disclose sending various types of advertising and promotional products, such as a free

Art Unit: 3622

or discounted print consumable, printable media (e.g. coupon), or product to the user (Griebenow, col 10, line 58 - col 11, line 22)(Logan, col 24, lines 1-14). While neither reference explicitly discloses that the advertising content includes a coupon, coupons are old and well known form of advertisements and would have been an obvious choice for the advertisers in Griebenow or in Logan. One would have been motivated to present a coupon to the user in order to entice the user to buy the product by clicking on the “purchase” or “order” link discussed in each reference.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Austin (6,157,924) discloses a method for automatically delivering preferred media to a printer with the preferred media incorporating advertising content along with the preferred content.

B. Okumura et al (6,178,424) discloses a method for automatically distributing information and for monitoring the usage of the information.

C. Whitmyer, Jr. (6,182,078) discloses a method for delivering professional services over the Internet with automatic delivery of reminders and forms to the user.

D. Herz (6,460,036) discloses a method for providing customized electronic newspapers to users based on the user's preferences.

Art Unit: 3622

E. Crandall (5,970,231) discloses a method for publishing an electronic newspaper which includes advertisements along with the content information.

F. Krishna et al (6,012,071) discloses a method for automatically distributing electronic publications.

G. Crandall (6,438,588) discloses a method for publishing an electronic newspaper which includes advertisements along with the content information.

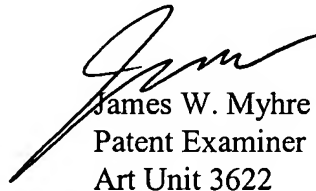
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
January 7, 2003



James W. Myhre
Patent Examiner
Art Unit 3622